

REMARKS

Claims 1-21 and 23-33 stand finally rejected. By this Preliminary Amendment which accompanies a Request for Continued Examination, Claims 1, 14, 17, and 29 have been amended. Favorable reconsideration of Claims 1-21 and 23-33 in light of the foregoing amendments and the following remarks is respectfully requested.

Rejection Under 35 U.S.C. § 112.

The Examiner rejected Claims 1-21 and 23-33 under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Examiner has stated that the term "easily" in Claims 1, 14, 17 and 29 is a relative term which renders the claims indefinite. Although the Examiner's position is respectfully traversed, the rejection has been rendered moot by the amendment of the claims. Accordingly, withdrawal of the rejection under § 112, second paragraph, is respectfully requested.

Rejection Under 35 U.S.C. § 102(b).

The Examiner rejected Claims 1, 6, and 14 under 35 U.S.C. § 102(b) as being anticipated by the Kirk reference (U.S. Patent No. 6,332,631). The Examiner's rejection is respectfully traversed.

Turning first to independent Claim 1, it recites an adhesive label comprising a label having first and second contiguous sections, wherein the second section forms a tab portion. The adhesive label further comprises an adhesive layer confined to the first section of the label and adapted to releasably adhere the first section to a substrate surface with a substantially uniform degree of adhesion, such that the entire label, including the entire adhesive layer, detaches from the substrate surface when a user grasps the tab portion and lifts it away from the substrate.

The Kirk reference does not disclose each and every limitation recited in Claim 1. In particular, the Kirk reference discloses a label having a first section (34 and 35) with an adhesive layer and a second section that forms a tab portion (left side of 38 in Fig. 3). The adhesive on one side of the first section is configured such that the first portion (34) is substantially permanently adhered to the substrate, while the adhesive on a second portion (36) of the first section is configured such that the second portion (36) is releasably adhered to the substrate. Thus, different portions of the label adhere to the substrate with different

degrees of adhesion such that a user may partially lift a label on a container to view printing on the back side of the label without detaching or destroying the portion of the label that is permanently attached to the container. The Kirk reference discloses that the two different degrees of adhesion are desirable because such an arrangement provides a label that, “when applied to a container, provide[s] a portion that may be peeled back to reveal extended text information, then easily re-sealed to the container after reviewing the extended text, and *which preclude[s] inadvertent removal of the entire label.*” Kirk reference, Col. 7, lines 26-31 (emphasis added).

Because the Kirk reference does not recite an adhesive layer configured to releasably adhere the first section of the label to the substrate with a substantially uniform degree of adhesion such that the entire label can be removed by lifting the tab portion away from the substrate, the Kirk reference cannot anticipate Claim 1 or any claim based on Claim 1. Accordingly, withdrawal of the rejection under 35 U.S.C. § 102(b) of Claim 1, and Claim 6 which depends therefrom, is respectfully requested.

To the extent that the Examiner may attempt to assert that providing a uniform degree of adhesion configured in the manner recited in Claim 1 would have been obvious in view of the Kirk reference, it is respectfully noted that a motivation to make such a modification to the label disclosed in the Kirk reference is entirely missing. More particularly, the label configuration disclosed in the Kirk reference is purposefully designed with two different degrees of adhesion to prevent inadvertent removal of the entire label. Thus, modification of the label disclosed in the Kirk reference such that it can be releasably adhered to a substrate with a *uniform* degree of adhesion would render the Kirk label useless and destroy its intended function. *In re Gordon*, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (holding that if a proposed modification would render the prior art invention unsatisfactory for its intended purpose, then the requisite suggestion or motivation to make the proposed modification is missing). Accordingly, it is respectfully submitted that the Examiner cannot establish a *prima facie* of obviousness based on the Kirk reference with respect to Claims 1 and 6, because a motivation to modify the Kirk reference in the needed manner is lacking.

Turning now to independent Claim 14, it recites an adhesive label comprising a first portion having opposing first and second sides, an adhesive layer on the first side of the first portion to releasably adhere the label to a substrate, and a second portion extending from an edge of the first portion and having a nonadhesive first side juxtaposed to the adhesive layer.

The adhesive layer is configured to maintain adherence of the label to a substrate during exposure to temperatures varying from approximately -10°C to $+50^{\circ}\text{C}$, and after exposure to such temperatures, is configured such that the entire adhesive label detaches from the substrate by pulling the nonadhesive second portion away from the substrate.

Again, the Kirk reference is deficient with respect to several of the limitations recited in independent Claim 14. For example, the Kirk reference does not teach or disclose that the label should be configured to function (i.e., remain adhered) during extreme temperature conditions such as those recited in Claim 14, and still entirely detach by merely pulling a nonadhesive portion away from the substrate. Accordingly, withdrawal of the rejection under 35 U.S.C. § 102(b) and favorable reconsideration of Claim 14 are respectfully requested.

To the extent that the Examiner may attempt to assert that Claim 14 is obvious in view of the Kirk reference because the Examiner may believe that functionality of the label during and after extreme temperature conditions is merely a matter of routine optimization or routine design, it is noted that all of the properties of the claimed invention as a whole as compared to those of the prior art should be considered when determining patentability. *See In re Dillon*, 16 U.S.P.Q.2d 1897, 1902 (Fed. Cir. 1990). With respect to Claim 14, it is respectfully submitted that because the recited label is configured to maintain functionality during and after exposure to temperature extremes, the recited label possesses significantly different properties which enable it to perform significantly differently from the label disclosed in the Kirk reference (i.e., the label remains adhered during exposure to temperature extremes and is *entirely* detachable after such exposure). Moreover, the Kirk reference is completely lacking as to any suggestion or motivation for providing a label possessing such properties since the Kirk reference does not provide any indication that the disclosed label will maintain functionality during and after exposure to temperature extremes or that exposure to such temperature extremes is even contemplated, much less desirable. Indeed, as discussed above, the label disclosed in the Kirk reference is designed such that only a *portion* of the label is ever detachable, even without consideration of exposure to extreme temperature conditions. Accordingly, it is respectfully submitted that a *prima facie* case of obviousness with respect to Claim 14 cannot be established based on the Kirk reference.

Rejections Under 35 U.S.C. § 103(a).

Claims 1, 6, and 14 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the Sullivan reference (U.S. Patent No. 5,172,936) in view of the Kirk reference. The Examiner's rejection is respectfully traversed.

The Sullivan reference discloses an in-mold label having a portion which is removable. The label comprises a permanent portion and a removable portion, each of which has a display side for printing indicia thereon and an adhering side provided with an appropriate degree of adhesion. More particularly, the adhering side of the permanent portion is provided with "a sufficient degree of adhesion to adhere the permanent portion(s) to the molded surface so as to maintain it substantially completely adhered to the molded surface." Sullivan reference, Col. 2, lines 45-49. The adhering side of the removable portion is provided with a sufficient degree of adhesion such that the adhesion between the molded surface and the removable portion is less than the tear modulus of the removable portion.

To establish a *prima facie* case of obviousness, all of the limitations recited in the subject claim must be taught or suggested in the prior art. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). With respect to independent Claim 1, it is respectfully submitted that the Sullivan reference, on its own, is deficient with respect to several limitations recited therein. For example, the Sullivan reference does not teach, disclose, or suggest an adhesive layer confined to the first side of the first section of the label and configured to provide a substantially uniform degree of adhesion to the substrate such that the entire label, including the entire adhesive layer, detaches from the substrate surface when a user grasps the tab portion and lifts it away from the substrate, as recited in Claim 1. Rather, the label disclosed in the Sullivan reference has an adhering side that provides two different degrees of adhesion such that one portion of the label is permanently adhered to the substrate while a second portion can be removed.

The Kirk reference does not compensate for the deficiencies of the Sullivan reference, because, as discussed above, the Kirk reference also does not teach, disclose, or suggest an adhesive layer providing a substantially uniform degree of adhesion to the substrate such that the entire label can be detached by pulling on the tab portion. Moreover, any attempt to modify the label disclosed in either reference to provide an adhesive layer having a uniform degree of adhesion such that the entire label can be detached would destroy the functionality

and intended purpose of the disclosed two-portion labels. Accordingly, the motivation to make such a modification is entirely lacking.

Thus, it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness based on the Sullivan reference combined with the Kirk reference, because the combined reference neither teach, disclose or suggest all of the recited limitations nor include a motivation to make the needed modification. For at least these reasons, withdrawal of the rejection under 35 U.S.C. § 102(b) and favorable reconsideration of Claim 1, as well as Claim 6 which is based thereon, are respectfully requested.

The Sullivan reference and the Kirk reference, either alone or in combination, also do not teach, disclose, or suggest all of the limitations recited in independent Claim 14. For example, neither reference teaches, discloses, or suggests a label that is adapted to remain adhered to a substrate during exposure to extreme temperature conditions and entirely detach from the substrate after such exposure by pulling the nonadhesive portion away from the substrate, as recited in Claim 14. As discussed above, both references disclose a label having two portions with differing degrees of adhesion such that it is impossible to detach the entire label, including the entire adhesive layer, from the substrate by merely pulling on the nonadhesive portion, as recited in Claim 14. Further, modifying the label disclosed in either of the Sullivan reference or the Kirk reference such that it could entirely detach would destroy the intended purpose of providing a label having two portions with differing degrees of adhesion.

As such, it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness in view of the Sullivan and Kirk references. Accordingly, withdrawal of the rejection under § 103(a) and favorable reconsideration of Claim 14 is respectfully requested.

Claims 2, 4, 5, 7-13, and 15 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the Kirk reference. The Examiner's rejection is respectfully traversed.

It is respectfully submitted that the previous discussion of the patentability of the invention recited in independent Claims 1 and 14 in view of the Kirk reference obviates the present rejection (see hypothetical discussion of Claims 1 and 14 in the section discussing the § 102(b) rejection). It is noted that Claims 2, 4, 5 and 7-13 are variously based on independent Claim 1, and Claim 15 depends from independent Claim 14. If an independent

claim is not obvious in view of particular art, then any claim depending therefrom also cannot be obvious in view of that art. See *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). In asserting the rejection of Claims 2, 4, 5, 7-13, and 15 under § 103, the Examiner has not cited any additional art which could compensate for the deficiencies of the Kirk reference that were highlighted above. Accordingly, for the same reasons discussed previously with respect to the obviousness of Claims 1 and 14 in view of the Kirk reference, it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness with respect to Claims 2, 4, 5, 7-13, and 15. Withdrawal of the rejection under 35 U.S.C. § 103(a) and favorable reconsideration of Claims 2, 4, 5, 7-13, and 15 thus are respectfully requested.

Claims 3, 16-21, and 23-33 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the Kirk reference in view of the Sechet reference (U.S. Patent No. 5,472,756). The Examiner's rejection is respectfully traversed.

Turning first to Claim 3, it is based on independent Claim 1. As previously discussed, the Kirk reference does not teach, disclose or suggest a label having an adhesive layer configured to releasably adhere the first section of the label to the substrate with a substantially uniform degree of adhesion such that the *entire* label can be removed by lifting the tab portion away from the substrate, as recited in independent Claim 1 and Claim 3 which depends therefrom.

The Sechet reference also does not teach, disclose, or suggest a label that can be entirely removed from the substrate. That is, the label disclosed in the Sechet reference is a two-part label equipped with a detachable part and a fixed part *that is intended to remain on the substrate when the detachable part is detached*. Accordingly, it is respectfully submitted that because the Sechet reference suffers from the same deficiency as the Kirk reference, the Examiner has failed to establish a *prima facie* case of obviousness based on the combination of the Kirk and Sechet references. As such, withdrawal of the rejection under § 103(a) and favorable reconsideration of Claim 3 are respectfully requested.

With respect to Claim 16, it is based on independent Claim 14. As previously discussed, the Kirk reference does not teach, disclose, or suggest a label having an adhesive layer that is configured to maintain adherence of the label to a substrate during exposure to temperatures varying from approximately -10°C to $+50^{\circ}\text{C}$, and that is further configured such that, after exposure to such extreme temperatures, the entire label, including the entire

adhesive layer, detaches from the substrate by pulling on the nonadhesive portion. The Sechet reference also does not teach, disclose, or suggest a label which is configured to remain adhered to the substrate during exposure to temperature extremes, and entirely detach from the substrate after such disclosure. Indeed, as previously discussed, the Sechet reference does not in any way teach, disclose, suggest, or even contemplate any type of label that can be *entirely* detached.

Based on the foregoing, it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness with respect to Claim 16 in view of the Kirk and Sechet references. Accordingly, withdrawal of the rejection under § 103(a) and favorable reconsideration of Claim 16 are respectfully requested.

Turning now to independent Claim 17, and Claims 18-21 and 23-28 which are based thereon, they recite an adhesive label comprising a label having first and second sections and an adhesive layer overlaying a side of the first section only. The label is adapted to be removed *entirely* from the substrate without tearing or leaving any remnant of the label or leaving residue from the adhesive layer by lifting the nonadhesive second portion away from the substrate. As previously discussed, neither the Kirk reference nor the Sechet reference, alone or in combination, teaches, discloses, or suggests a label that can be removed *entirely* from a substrate without tearing or leaving any remnant of the label or leaving residue from the adhesive layer by simply lifting a nonadhesive portion away from the substrate. Accordingly, it is respectfully submitted that a *prima facie* case of obviousness with respect to Claim 17, and Claims 18-21 and 23-28 which are based thereon, has not been established. As such, withdrawal of the rejection under § 103(a) and favorable reconsideration of Claims 17-21 and 23-28 are respectfully requested.

With respect to independent Claim 29, and Claims 30-33 which are based thereon, they recite an adhesive label comprising a first portion, a second portion, and an adhesive layer on a first side of the first portion. The second portion has a nonadhesive first side juxtaposed to the adhesive layer. The *entire* adhesive label is adapted to be removed from a substrate after exposure to temperatures ranging between approximately -10°C and +50°C by pulling the nonadhesive second portion away from the substrate. Again, neither the Kirk reference nor the Sechet reference, either alone or in combination, teaches, discloses, or suggests an entire adhesive label that can be removed from a substrate by pulling the nonadhesive portion away from the substrate. Further, neither the Kirk reference nor the

Sechet reference, alone or in combination, contemplate a label which can maintain functionality (i.e., be entirely detached from a substrate) after exposure to temperatures between -10°C and +50°C. Based on the foregoing, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness with respect to Claims 29-33. Accordingly, withdrawal of the rejection and favorable reconsideration of Claims 29-33 are respectfully requested.

CONCLUSION

Based on the foregoing amendments and remarks, it is believed that this application is now in condition for allowance, and a notice to that effect is earnestly solicited. In the event that minor claim amendments are necessary to meet formal requirements or that a telephonic interview will otherwise help expedite issuance of a Notice of Allowance, the Examiner is kindly invited to call the undersigned at the number provided below.

Respectfully Submitted,

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VERSION WITH MARKING TO SHOW CHANGES MADE

Please amend Claims 1, 14, 17, and 29 as follows:

1. (Twice Amended) An adhesive label, comprising:

a label having a first and second [section] sections, each section having first and second opposite sides, wherein the first side of the first section is contiguous with the first side of the second section, and wherein the second section forms a tab portion extending from an edge of the first section; and

an adhesive layer adapted to releasably adhere the label to a substrate surface, the adhesive layer confined to covering at least a portion of the first side of the first section and configured such that the degree of adhesion of the first side of the first section to the substrate surface is substantially uniform such that the entire label, including the entire adhesive layer, detaches from the substrate surface when the tab portion is grasped by a user and lifted away from the substrate surface.

[the second section forming a tab portion extending from an edge of the first section; and

wherein, the first side of the second section does not include an adhesive layer, whereby the entire label is adapted to be easily removed from a substrate surface by lifting the tab portion away from the substrate surface.]

14. (Twice Amended) An adhesive label, comprising:

a first portion having opposing first and second sides;

an adhesive layer on the first side of the first portion, the adhesive adapted to releasably adhere the label to a substrate;

a second portion extending from an edge of the first portion, the second portion having a nonadhesive first side juxtaposed to the adhesive layer on the first side of the first portion;

the second side of the first portion has a surface adapted to be written upon with a pencil and/or pen; and

wherein, the adhesive label is adapted to remained adhered to a substrate during exposure to temperatures ranging between approximately -10°C and +50°C, and the entire adhesive label, including the entire adhesive layer, can be removed from [a] the substrate after exposure to temperatures ranging between approximately -10°C and +50°C by pulling the nonadhesive second portion away from the substrate[, whereby the entire label is easily lifted from the substrate].

17. (Twice Amended) An adhesive label, comprising:

a label having first and second sections, each section having contiguous first and second opposite sides;

an adhesive layer adapted to releasably adhere the label to a substrate, the adhesive layer overlaying the first side of the first section only;

the second section forming a tab portion extending horizontal to the first section, the tab portion having an edge interconnected with an edge of the first section, the interconnected edges forming a rounded edge, and the first side of the second section being nonadhesive;

wherein, the label is adapted to be removed entirely from a substrate without tearing or leaving any remnant of the label or leaving residue from the adhesive layer by lifting the nonadhesive second section away from the substrate[so as to easily lift the entire label from the substrate].

29. (Twice Amended) An adhesive label, comprising:

a first portion having opposing first and second sides;

an adhesive layer on the first side of the first portion, the adhesive adapted to releasably adhere the label to a substrate;

a second portion extending from an edge of the first portion, the second portion having a nonadhesive first side juxtaposed to the adhesive layer on the first side of the first portion;

the second side of the first portion has a surface adapted to be written upon with a pencil and/or pen;



the second side of the first portion has a surface adapted to accept printing relating to food safety labeling systems; and

wherein, the entire adhesive label is adapted to be removed from a substrate after exposure to temperatures ranging between approximately -10°C and $+50^{\circ}\text{C}$ by pulling the nonadhesive second portion away from the substrate[, whereby the entire label is easily lifted from the substrate].

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